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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

TRIPLE TEE GOLF, INC.,
a Florida corporation,

Plaintiff,

VS.

TAYLOR-MADE/ADIDAS,
a Delaware corporation,

Defendant.

Case No. 11-CV-2974 JLS (WVG)

ORDER GRANTING DEFENDANT'S MOTION FOR SUMMARY JUDGMENT

(ECF No. 40)

17 Presently before the Court is Defendant Taylor Made Golf Company, Inc.’s
18 (“Defendant”) Motion for Summary Judgment (“MSJ”). (ECF No. 40). Also before the
19 Court is Plaintiff Triple Tee Golf, Inc.’s (“Plaintiff”) Response in Opposition to (ECF
20 No. 43) and Defendant’s Reply in Support of (ECF No. 44) the Motion. A hearing on
21 the motion was held on February 19, 2015. Having considered the parties arguments
22 and the law, the Court **GRANTS** Defendant’s Motion for Summary Judgment.

BACKGROUND

24 In 2011, Plaintiff filed the initial complaint in this matter, alleging infringement
25 of two patents—United States Patent Nos. 7,128,660 (“the ‘660 patent”) and 7,854,667
26 (“the ‘667 patent”), which are both titled “Method of Golf Club Performance
27 Enhancement and Articles Resultant Therefrom.” (ECF No. 1.) Then, in 2012, the
28 parties filed a Joint Motion to Stay Litigation Pending *Inter Partes* Reexamination of

1 the Patents-in-Suit. (ECF No. 26.) The Court granted the Joint Motion. (ECF No. 27.)

2 On July 20, 2012, Defendant filed a request for an *inter partes* reexamination of
 3 the two patents. (MSJ 9, ECF No. 40-1.) The result of the *inter partes* reexamination
 4 was the cancellation of all claims of the ‘660 patent except claims 7, 9 and 15. (*Id.* at
 5 9–10.) Then, on February 6, 2013, Defendant filed a request for an *ex parte*
 6 reexamination of claim 9. (*Id.* at 10.) After the patent examiner rejected claim 9 as
 7 anticipated by another patent, Dammen, Plaintiff “responded to the office action by
 8 cancelling claims 9 and 15, amending claim 7, and adding several new claims.” (*Id.* at
 9 11.) Plaintiff later cancelled some of the newly added claims, and added three new
 10 claims. (*Id.* at 11–12.)

11 Ultimately, the United States Patent and Trademark Office’s reexaminations of
 12 the patents resulted “in invalidation of all but four claims of the ‘660 patent and
 13 invalidation of all claims of the ‘667 patent.” (Status Report 2,¹ ECF No. 29.) The four
 14 remaining claims in the ‘660 patent include original claim 7, and claims 20, 21, and 22,
 15 which Plaintiff added during the *ex parte* reexamination of the ‘660 patent.² (*Id.* at
 16 4–5.) Of the remaining claims, claim 20 is an independent claim, while claims 7, 21
 17 and 22 are dependent claims. (*Id.* at 5.)

18 The ‘660 patent “relates to ‘a method of selectively varying the center of gravity
 19 and distribution of weighting in a void space in the head of a golf club,’” based on the
 20 needs of a particular golfer. (MSJ 7, ECF No. 40-1 (quoting ‘660 Patent 1:19–21).) The
 21 ‘660 patent focuses on having a variety of positions for the center of gravity,
 22 distribution of weight, or weights within the head of the club. (‘660 Patent 1:64–67.)
 23 There are 27 potential locations in the void space located on an orthonormal matrix
 24

25 ¹For ease of reference, all page numbers cited to are the CM/ECF numbers at the top
 26 of the page.

27 ²Defendant argues that new claim 20 is essentially the same as old claim 9, which the
 28 patent examiner rejected as anticipated by Dammen. (MSJ 12 n.3, ECF No. 40-1.) The only
 difference is additional language about weighting strategy (c)(I), “which had nothing to do
 with the Examiner’s rejection of claim 9 based on Dammen.” (*Id.*) Accordingly, Defendant
 states it will argue that claim 20 is invalid over Dammen if this case proceeds. (*Id.*)

1 comprised of three axes (x, y and z). (*Id.* at 2:1–3.) Depending on a golfer’s needs, he
2 or she can adjust the center of gravity, distribution of weight, and/or weights
3 accordingly. (*See id.* at 1:64–2:5.) For example, according to the patent specification,
4 a golfer can modify his or her backspin by weighting means at a low Y, low Z
5 coordinate to increase backspin, or at a high Y, high Z coordinate to decrease backspin.
6 (*Id.* at 2:48–51.) Changing the weighting means can affect backspin, penetration,
7 trajectory and hook or slice. (*Id.* at 2:62–67.)

8 In its First Amended Complaint (“FAC”), Plaintiff alleges that Defendant
9 directly infringed the ‘660 patent by, “among other things, making, using, importing,
10 advertising, offering for sale to the public, [and] selling” various golf clubs. (FAC ¶ 19,
11 ECF No. 31.) Plaintiff also alleges that Defendant “actively [induced] its agents,
12 distributors, and end users, among others, to employ products that infringe the method
13 of [the ‘660 patent],” thereby inducing patent infringement. (*Id.* at ¶ 27.) Finally,
14 Plaintiff alleges Defendant committed contributory patent infringement “by, among
15 other things, selling one or more articles or materials such as weight adjustment guides,
16 booklets, videos and tools, which enable infringement of the patented method of the
17 [‘660 patent], especially such materials adapted for use in the infringement of
18 Plaintiff’s Patent that are not staple articles of commerce.” (*Id.* at ¶ 35.)

19 Defendant responds in the MSJ that it has “discontinued the manufacture and
20 importation of each of the Accused Products.” (MSJ 13, ECF No. 40-1.) Defendant
21 further explains that it has not manufactured in this country nor imported into this
22 country any of the Accused Products since before the issuance of the *Ex Parte*
23 Reexamination Certificate of the ‘660 patent. (*Id.*) Defendant also has no plans to
24 manufacture or import any of the Accused Products in the future. (*Id.*)

LEGAL STANDARD

26 || I. Summary Judgment

27 Summary judgment is appropriate where the Court is satisfied that “there is no
28 genuine issue as to any material fact and that the moving party is entitled to a judgment

1 as a matter of law.” Fed. R. Civ. Pro. 56(c); *Celotex Corp. v. Catrett*, 477 U.S. 317,
 2 322 (1986). Material facts are those that may affect the outcome of the case. *Anderson*
 3 *v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A genuine issue of material fact
 4 exists only if “the evidence is such that a reasonable jury could find for the nonmoving
 5 party.” *Id.* When the Court weighs the evidence to be presented by the parties, “[t]he
 6 evidence of the nonmovant is to be believed, and all justifiable inferences are to be
 7 drawn in [his] favor.” *Id.* at 255.

8 The initial burden of establishing the absence of a genuine issue of material fact
 9 falls on the moving party. *Celotex*, 477 U.S. at 323. The movant can carry his burden
 10 in two ways: (1) by presenting evidence that negates an essential element of the
 11 nonmoving party’s case; or (2) by demonstrating to the Court that the nonmoving party
 12 “failed to make a sufficient showing on an essential element of her case with respect
 13 to which she has the burden of proof.” *Id.* at 322–23.

14 Once the moving party satisfies this initial burden, the nonmoving party must set
 15 forth specific facts showing that there is a genuine issue for trial. *Celotex*, 477 U.S. at
 16 324. To do so, the nonmoving party must “do more than simply show that there is
 17 some metaphysical doubt as to material facts.” *Matsushita Elec. Indus. Co. v. Zenith*
 18 *Radio Corp.*, 475 U.S. 574, 586 (1986). Rather, to survive summary judgment, the
 19 nonmoving party must “make a showing sufficient to establish the existence of [every]
 20 element essential to that party’s case, and on which that party will bear the burden of
 21 proof at trial.” *Celotex*, 477 U.S. at 322. Furthermore, the nonmoving party cannot
 22 oppose a properly supported motion for summary judgment by “rest[ing] on mere
 23 allegations or denials of his pleadings.” *Anderson*, 477 U.S. at 256. Rather, the
 24 nonmoving party must identify those facts of record that would contradict the facts
 25 identified by the movant. *Id.* at 256–57.

26 **II. Legal Effect of Reexamination**

27 “Any proposed amended or new claim determined to be patentable and
 28 incorporated into a patent following a reexamination proceeding will have the same

1 effect as that specified in [35 U.S.C. § 252] for reissued patents.” 35 U.S.C. § 307(b).
 2 35 U.S.C. § 252 provides that if
 3

4 the claims or the original and reissued patents are substantially identical,
 5 [surrender of the original patent] shall not affect any action then pending
 6 nor abate any cause of action then existing, and the reissued patent, to
 7 the extent that its claims are substantially identical with the original
 8 patent, shall constitute a continuation thereof and have effect
 9 continuously from the date of the original patent.

10 Accordingly,
 11

12 [a] patentee of a reexamined patent is entitled to infringement damages,
 13 *inter alia*, for the period between the date of issuance of the original
 14 claims and the date of issuance of the reexamined claims if the original
 15 and reexamined claims are identical. Reexamined claims are identical to
 16 their original counterparts if they are without substantive change.
 17 Furthermore, in determining whether substantive changes have been
 18 made, [the court] must discern whether the scope of the claims are
 19 identical, not merely whether different words are used. If substantive
 20 changes have been made to the original claims, the patentee is entitled
 21 to infringement damages only for the period following the issuance of
 22 the reexamination certificate.

23 *Laitram Corp. v. NEC Corp.*, 163 F.3d 1342, 1346 (Fed. Cir. 1998) (internal quotations
 24 and citations omitted). “An amendment that clarifies the text of the claim or makes it
 25 more definite without affecting its scope is viewed as identical for the purpose of §
 26 252.” *Bloom Eng’g Co., Inc. v. N. Am. Mfg. Co., Inc.*, 129 F.3d 1247, 1250 (Fed. Cir.
 27 1997) (internal citations omitted).

28 Whether a reexamined claim and an original claim are substantially identical is
 1 a question of law for the Court to decide. *See Laitram*, 163 F.3d at 1346–47 (citing
 2 *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 970–71 (Fed. Cir. 1995) (en
 3 banc)). To determine whether a reexamined claim is substantially identical to an
 4 original claim, “it is necessary to analyze the claims . . . in light of the particular facts,
 5 including the prior art, the prosecution history, other claims, and any other pertinent
 6 information.” *Id.* at 1347 (internal quotations and citations omitted). This includes
 7 following “the well-established principle that a court may not import limitations from

1 the written description into the claims.” *Id.*

2 35 U.S.C. § 252 also establishes intervening rights for reissued patents, which
3 apply to reexamined patents as well. *See* 35 U.S.C. § 307(b). 35 U.S.C. § 252 reads that
4

5 [a] reissued patent shall not abridge or affect the right of any person or
6 that person's successors in business who, prior to the grant of a reissue,
7 made, purchased, offered to sell, or used within the United States, or
8 imported into the United States, anything patented by the reissued
9 patent, to continue the use of, to offer to sell, or to sell to others to be
used, offered for sale, or sold, the specific thing so made, purchased,
offered for sale, used or imported unless the making, using, offering for
sale, or selling of such thing infringes a valid claim of the reissued
patent which was in the original patent.³

10 This provision gives an accused infringer “the absolute right to use or sell a product
11 that was made, used or purchased before the grant of the reissue [or reexamined] patent
12 as long as this activity does not infringe a claim of the reissue patent that was in the
13 original patent.” *BIC Leisure Products, Inc. v. Windsurfing Int'l, Inc.*, 1 F.3d 1214,
14 1220–21 (Fed. Cir. 1993). This means that “[a]s long the use or sale of the accused
15 product does not infringe a claim of the reissue patent that was also in the original
16 patent, the owner of the reissued patent has no recourse under the Patent Act.” *Id.* at
17 1221. This provision gives an alleged infringer an absolute intervening right “to
18 continue what would otherwise be infringing activity” in regard to those products that
19 were made, purchased, or used prior to the grant of the reissue patent or reexamination
20 certificate. *Seattle Box Co. v. Indus. Crating & Packaging, Inc.*, 756 F.2d 1574, 1579
21 (Fed. Cir. 1985); *see id* at 1221.

22 ANALYSIS

23 New claim 20, which requires selectively employing two of the four claimed
24 weighting strategies, “is most similar to original dependent claim 9,” because “of the
25 two [original] independent claims in the ‘660 patent, claims 1 and 11, only claim 1
26

27 ³35 U.S.C. § 252 also establishes an equitable intervening right which a court may
28 afford to an accused infringer that first makes or uses accused products after reissue, but who
made substantial preparation prior to reissue. Defendant “is not asserting equitable intervening
rights at this time.” (MSJ 17–18, ECF No. 40-1.)

1 (from which claim 9 depended) [also] recited selectively employing two of four claimed
 2 weighting strategies.” (MSJ 12, ECF No. 40-1.) Additionally, new claim 20 requires
 3 and, of the original claims, only claim 9 “required that ‘at least one selected strategy
 4 includes weighting means not contiguous with any inner surface of said void space.’”
 5 (*Id.* (quoting Clark Dec’1 ¶ 19, ECF No. 40-2).) Accordingly, the MSJ compares and
 6 contrasts the new claims with original, dependent claim 9.

7 Defendant argues that Plaintiff is not entitled to infringement damages for the
 8 time prior to the issuance of the reexamined claims of the ‘660 patent because new
 9 claim 20 is not substantially identical to original claim 9, nor are amended claim 7 and
 10 new claims 21 and 22 substantially identical to original claim 9. (MSJ 18, 26, ECF No.
 11 40-1.) Accordingly, Defendant argues that it is entitled to summary judgment on each
 12 of Plaintiff’s counts in the FAC. (*Id.* at 27.) The Court agrees.

13 **I. New Claim 20**

14 In regard to new claim 20, Defendant argues that it differs from original claim
 15 9 in two ways based on newly added language, which reads, “an increase in a Z-axis
 16 value does not correspond to a decrease in the Y-axis value.”⁴ (*Id.* at 18.) First,
 17 Defendant argues this added phrase imposes a new requirement that the location of the
 18 weighting means along the Y and X axes be adjustable. (*Id.*) Second, Defendant argues
 19 that this also requires that the “adjustment is restricted to a path that defines a non-
 20 decreasing function between low Y, low Z coordinate to a high Y, high Z coordinate.”
 21 (*Id.*)

22 **A. Adjustable Weighting Means**

23 Utilizing the general principles of claim construction, Defendant explains that
 24 claim terms are generally “given their ‘ordinary and customary’ meaning, which is ‘the
 25 meaning that the term would have to a person of ordinary skill in the art in question at
 26 the time of the invention.’” (*Id.* at 19 (quoting *Phillips v. AWH Corp.*, 415 F.3d 1303,
 27

28 ⁴Plaintiff agrees that new claim 20 and original claim 9 are identical except for the
 addition of this phrase. (Resp. in Opp’n 7, ECF No. 43.)

1 1312–13 (Fed. Cir. 2005) (*en banc*)). A claim should be read “in the context of the
 2 entire patent, including the specification,” but the court should not import limitations
 3 from the specification into the claims. (*Id.* (quoting *Phillips*, 415 F.3d at 1313).) Courts
 4 consider “the words of the claims themselves, the remainder of the specification, the
 5 prosecution history, and extrinsic evidence concerning relevant scientific principles,
 6 the meaning of technical terms, and the state of the art” to discern a claim’s ordinary
 7 and customary meaning. (*Id.* (quoting *Phillips*, 415 F.3d at 1314).) In determining a
 8 claim’s meaning, a court first considers the words of the claim themselves, then may
 9 look to other intrinsic evidence, such as the patent specification and the prosecution
 10 history, and then, if necessary, extrinsic evidence. (*See* Resp. in Opp’n 8–9, ECF No.
 11 43 (citing *Vitronics Corp. v. Concentronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)).)

12 Applying these principles, Defendant explains that the newly added phrase,
 13 specifically “an increase in the Z-axis value,” must mean that the weighting means can
 14 be adjusted because to increase the Z-axis value requires the weighting means already
 15 be “present in the golf club head at another location having a lower Z-axis value.” (*Id.*
 16 at 19–20.) The adjustment may correspond to a change in the location of the weighting
 17 means along the Y-axis, but may not cause a decrease in the location along the Y-axis.
 18 (*Id.*)

19 Defendant argues that this differs from original claim 9,⁵ which “lacked any
 20 language indicating that the weighting means must be adjustable within the claimed
 21 ranges.” (*Id.* at 20 (quoting Beach Dec’1 ¶ 20, ECF No. 40-3).) Original claim 9 read
 22 “providing within said void space weighting means between a low Y, low Z
 23 coordinate to increase backspin to a high Y, high Z coordinate” to decrease backspin.
 24 (*Id.* (quoting Beach Dec’1 ¶ 20, ECF No. 40-3).) Defendant argues that the original
 25 claim’s strategy “was satisfied by simply placing a weighting means at the desired
 26 location during design and manufacture, without any implication that its location might

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 28 ⁵Reference to original claim 9 also refers to original claim 1, upon which original claim
 9 depended.

1 be adjusted.” (*Id.* (citing Beach Dec’1 ¶ 20, ECF No. 40-3).) Defendant supports this
 2 argument by noting that all except for one of the ‘660 patent’s embodiments disclose
 3 “club heads with fixed weights,” such that they could not be adjusted. (*Id.*; *see e.g.*,
 4 Clark Dec’1 ¶ 4, Ex. A, ECF No. 40-2).)

5 Defendant contends that the patent examiner confirmed their interpretation of
 6 original claim 9 during the *ex parte* reexamination of claim 9, by stating that ““the
 7 claim does not recite adjustability of the weights for different weighting strategies”” in
 8 response to Plaintiff’s argument that the claim contemplated adjustable weighting
 9 means. (*Id.* (quoting Clark Dec’1 ¶ 13, Ex. D at p. 56, ECF No. 40-2).) Defendant also
 10 asserts that the Board of Patent Appeals and Interferences (now the Patent Trial and
 11 Appeal Board) (“Board”), issued a similar statement in regard to claim 1 of the ‘667
 12 patent, which “was a continuation-in-part of the ‘660 patent” and which “recited a
 13 similar limitation to the weighting strategy” outlined in original claim 9. (*Id.* at 20–21.)
 14 The Board, in response to Plaintiff’s assertion that the weighting elements were
 15 adjustable, held “that the claims of the ‘667 patent ‘do not require adjustability’ or
 16 embody ‘any requirement of a capability of adjusting or moving a weight element along
 17 or within the claimed range.’”⁶ (*Id.* at 21 (quoting Clark Dec’1 ¶ 23, Ex. K at p. 127,
 18 ECF No. 40-2).)

19 Defendant concludes that because new claim 20 provides for adjustable
 20 weighting means along the Z and Y axes where original claim 9 did not, the new claim
 21 is not substantially identical to the original claim. (*Id.* at 21.)

22 Plaintiff responds to Defendant’s argument that original claim 9 did not require
 23 adjustable weighting means by refuting the Declaration of Todd Beach with its own
 24 declaration submitted by John P. Gilling, the inventor. (*See* Resp. in Opp’n 13, ECF
 25

26 ⁶Plaintiff argues that any reliance on the ‘667 patent prosecution history should be
 27 disregarded because the ‘667 patent recited the term “securing” whereas the ‘660 patent recited
 28 the term “provided,” and, therefore, the conclusion that the ‘667 patent did not require
 adjustable weighting means has no bearing on whether the original claims in the ‘660 patent
 require adjustable weighting means. (Resp. in Opp’n 15, ECF No. 43.) The Court declines to
 consider the ‘667 patent prosecution history.

1 No. 43.) Gillig explains that the original claim recited adjustability of the weighting
 2 means based on the phrases ““to modify back spin,’ ‘to modify ball penetration’ and ‘to
 3 modify ball trajectory”” in parts (c)(I), (c)(ii), and (c)(iii) of the original claim. (Gillig
 4 Dec’1 ¶ 20, ECF No. 43-2.) Gillig asserts that the term modify “inherently indicates a
 5 capability of adjustment,” as does the reference in the claim to the term “between,”
 6 which allows the coordinate of the weighting means to fall within a given range. (*Id.*)
 7 Gillig further argues against Defendant’s contention that the original claim allowed for
 8 the placement of the weighting means at a given spot during design and manufacture,
 9 “without ability to adjust its location,” by asserting that the continued use of the terms
 10 “modify” and “between,” along with Figure 5 in the ‘660 patent “should render beyond
 11 question that [the ‘660 patent] always related to adjustable weighting locations within
 12 a 3x3x3 orthonormal matrix of weighting elements.” (*Id.* at ¶ 21.)

13 As an initial matter, the Court confirms that determining whether a reexamined
 14 claim and an original claim are substantially identical is a question of law for the Court
 15 to decide. *See id.* at 1346–47 (citing *Markman v. Westview Instruments, Inc.*, 52 F.3d
 16 967, 970–71 (Fed. Cir. 1995) (en banc)). Accordingly, Plaintiff’s suggestion that
 17 disagreements among the declarations submitted by each party preclude a finding of
 18 summary judgment are misplaced. The Court may look to the extrinsic evidence
 19 submitted by each side to construe a term if it cannot discern a claim’s meaning based
 20 on the words themselves or the other intrinsic evidence. *Vitronics Corp. v.*
 21 *Conceptronic, Inc.*, 90 F.3d 1576, 1585 (Fed. Cir. 1996). Given the hierarchy of
 22 evidence and the requirement that extrinsic evidence only be relied upon if necessary,
 23 it is not even certain that the Court would consider the declarations in its construction
 24 of new claim 20 and old claim 9.

25 The parties do not disagree that new claim 20 requires adjustable weighting
 26 means, but do disagree over whether original claim 9 also required such adjustability.
 27 The Court agrees with Defendant that new claim 20 requires adjustable weighting
 28 means whereas old claim 9 did not require such adjustability and, therefore, that new

1 claim 20 is not substantially identical to original claim 9.

2 The Court finds that Gillig's reliance on the term "modify" in original claim 9
3 unpersuasive because, as Defendant asserts in its Reply, "modify" refers to altering
4 backspin, ball penetration, and ball trajectory, and not modifying the placement of the
5 weighting means. (Reply 7, ECF No. 44.) Similarly, the Court concludes that Gillig's
6 contention that the word "between" in original claim 9 represents ability to adjust the
7 weighting means within a given range equally unpersuasive because that simply means
8 that the weighting means could have been placed within the range during design and
9 manufacture. Original claim 9 recites "providing . . . weighting means between a low
10 Y, low Z coordinate . . . to a high Y, high Z coordinate." ('660 Patent 7:66–8:2.)
11 Nowhere in section (c)(I) of original claim 9, nor in the rest of the original claim is
12 there a suggestion that the weighting means must be adjustable; they must simply be
13 provided within the given range. Accordingly, an analysis of the words in original
14 claim 9 leads the Court to conclude that it did not require adjustable weighting means.

15 Additionally, the '660 patent prosecution history confirms this conclusion.
16 During the reexamination of the '660 patent, the patent examiner stated that "[t]he
17 claim does not recite adjustability of the weights for different weighting strategies."
18 (Clark Dec'1, Ex D, Office Action in *Ex Parte Reexamination: Non-Final Rejection* 55,
19 ECF No. 40-2.) Lastly, the Court's analysis accords with the general principle that
20 limitations found solely in the patent specification are not imported into claims for
21 purposes of claim construction. Gillig's statement that Figure 5 from the '660 patent
22 specification somehow supports a finding of adjustability, even if correct, cannot be
23 used to import limitations into the claim. In light of the Court's conclusion that original
24 claim 9 did not require adjustable weighting means, the Court finds that new claim 20
25 and original claim 9 are not substantially identical.

26 ///

27 ///

28 ///

B. Restrictions on Adjustment of Weighting Means

2 Defendant further argues that new claim 20 differs from original claim 9 because
3 it “clearly contemplates a path for adjusting the weighting means in which the Z-axis
4 value increases in order to decrease backspin,” and requires that ““an increase in Z-axis
5 value cannot correspond to a decrease in Y-axis value.”” (MSJ 21, ECF No. 40-1.) This
6 “defines a non-decreasing function between the Z- and Y-axis values of the weighting
7 means.” (*Id.* (citing Beach Dec’l ¶ 24, ECF No. 40-3).) An increase in the Z-axis value
8 “precludes a decrease in the Y-axis value of the weighting means, implicitly allowing
9 the Y-axis value to increase or remain constant.” (*Id.* (citing Beach Dec’l ¶ 24, ECF
10 No. 40-3).)

11 Defendant asserts that original claim 9 did not contain the restriction that as the
12 value of the Z-axis increases, the value of the Y-axis must increase or stay constant.
13 (*Id.* at 22.) Original claim 9 “allowed the weighting means to be positioned anywhere
14 between a low Y, low Z coordinate to a high Y, high Z coordinate,” which “meant that
15 the weighting means could be provided just about any place within the golf club head.”
16 (*Id.* (citing Beach Dec’1 ¶ 25, ECF No. 40-3).)

17 Defendant argues that Plaintiff’s assertion that new claim 20 does not change the
18 scope of original claim 9 is incorrect because the only way for Plaintiff to be correct
19 is if “the *only* way to achieve decreasing backspin between a low Y, low Z coordinate
20 to a high Y, high Z coordinate . . . would be to follow a path defined by a non-
21 decreasing function,” such that backspin would only decrease if an increase in the
22 value of the Z axis does not correspond with a decrease in the value of the Y-axis. (*Id.*)
23 Defendant explains that decreasing backspin can be achieved by increasing the value
24 along the Z-axis with a corresponding decrease along the Y-axis, as long as “the
25 backspin change from a positive movement along the Z-coordinate is larger than the
26 backspin change from a negative movement along the Y-coordinate.”⁷ (*Id.* at 24.)

⁷Defendant provides a comprehensive explanation of the center of gravity of golf club heads and its affect on backspin to show that a decrease in backspin need not be the result of a increase along the Z-axis without any corresponding decrease along the Y-axis. (See MSJ

1 Therefore, Defendant argues that new claim 20 has a different scope than original claim
 2 9 because the limitation imposed by new claim 20 was not inherent in original claim
 3 9. (*Id.* at 26.) Accordingly, Defendant argues that the new claim is not substantially
 4 identical to the original claim in regard to the restrictions it imposes on the path of the
 5 weighting means. (*Id.*)

6 Plaintiff, in contrast, argues that the phrase added to new claim 20 does not
 7 change the scope of original claim 9 by restricting the adjustable weighting means to
 8 a specific path, which, it contends, Gillig's declaration proves. (*See* Resp. in Opp'n 13,
 9 ECF No. 43.) Gillig asserts that the added language in new claim 20 "simply assured
 10 that Strategy (c)(I) could not possibly include any aspect of the strategy of Dammen,"
 11 which calls for an increase along the Z-axis to correspond with a decrease along the Y-
 12 axis, and, "therefore did not narrow, broaden or change the scope of original Claims
 13 1 and 9." (Gillig Dec'1 ¶ 22, ECF No. 43-2.) Gillig agrees that the new phrase can be
 14 described as "'a non-decreasing function between a low Y, low Z coordinate to a high
 15 Y, high Z coordinate,'" and concurs that this function is not the only way to change
 16 backspin. (*Id.* at ¶¶ 24, 27 (quoting Beach Dec'1 ¶ 24, ECF No. 40-3).) However, Gillig
 17 states that the '660 patent "requires concurrent incrementation of weighting along each
 18 Y and Z axis *and prohibits any deviation or excursion* from that such strategy," and
 19 that the original patent never permitted an increase in the Z axis to correspond with a
 20 decrease in the Y axis. (*Id.* at ¶ 32 (emphasis in original).) Plaintiff briefly concludes
 21 that Figure 5 in the '660 patent shows that "the weighting path of Claim 9 was always
 22 restricted." (Resp. in Opp'n 13, ECF No. 43.)

23 Similar to the first issue, the parties agree that new claim 20 restricts the path of
 24 the weighting means, that the added language represents a non-decreasing function, and
 25 that the non-decreasing function is not the only way to modify backspin. The parties
 26

27 22–26, ECF No. 40-1.) Defendant also notes it has determined that the weighting strategy at
 28 issue, as recited in original claim 9 and new claim 20, is incorrect because a low Y, low Z
 coordinate decreases backspin and a high Y, high Z coordinate increases backspin, but that
 does not change its analysis regarding the scope of the two claims. (*Id.* at 23, n.6.)

1 disagree, however, over whether the restricted path recited in new claim 20 was
 2 inherent in original claim 9.⁸ The Court concludes that restriction on the path of the
 3 weighting means was not inherent in the original claim and that, therefore, new claim
 4 20 is not substantially identical to original claim 9 for this additional reason.

5 Beginning with an analysis of the words of the claims themselves, it is clear that
 6 original claim 9 did not recite the limitation included in new claim 20 which reads “in
 7 which an increase in a Z-axis value cannot correspond to a decrease in Y-axis value.”
 8 (‘660 Ex Parte Reexamination Certificate 2:15–18.) The words of original claim 9
 9 themselves do not limit the path for the weighting means. Plaintiff argues that
 10 notwithstanding the lack of the recitation of this limitation in the original claim, the
 11 ‘660 patent specification, particularly Figure 5, make this limitation inherent in the
 12 original claim such that the amendment merely clarified the original claim. This
 13 argument, however, is contrary to the well-established principle that prohibits courts
 14 from importing limitations found only in the patent specification into the claims.
 15 *Laitram*, 163 F.3d at 1347 (noting “the well-established principle that a court may not
 16 import limitations from the written description into the claims”). The Court finds that
 17 nothing in the original claims suggest that the weighting means have to be placed at a
 18 specific location in accordance with the path shown in Figure 5 and that, therefore, new
 19 claim 20 is not substantially identical to original claim 9.

20 The ‘660 patent prosecution history is also instructive. That original claim 9 was
 21 cancelled at least partly on the ground that it was anticipated by Dammes is telling.
 22 Contrary to Plaintiff’s belief that the weighting path in original claim 9 was always
 23 restricted per Figure 5, the patent examiner, in response to then-pending claim 28,
 24 which was similar to original claim 9, explicitly “advised the Patent Owner’s rep to
 25 amend claim 28 to add recitation along the lines that a weighting strategy of increasing
 26 the Z axis does not include decreasing the Y-axis,” the very path Dammes teaches.
 27

28 ⁸The parties also disagree over the precise meaning of the added language in new claim
 20; however, “the main dispute is whether any such limitation was inherent in original claim
 9.” (Reply 9, ECF No. 44.)

1 (Clark Dec'l, Ex. F, *Ex Parte* Reexamination Interview Summary 79, ECF No. 40-2.)
 2 The patent examiner seems to have been assisting the patent owner in his endeavor to
 3 overcome Dammen and specifically suggested the inclusion of a more definite
 4 weighting path to ensure that it excluded the path taught by Dammen. The patent
 5 examiner did not conclude that this limitation was inherent in original claim 9 and
 6 neither does the Court.

7 In addition, the difference between new claim 20 and original claim 9 is similar
 8 to the situation in *Bloom*, in which the patent owner added limiting words to claims to
 9 overcome prior art. *Bloom Eng 'g Co., Inc.*, 129 F.3d at 1250–51. In that case, the patent
 10 owner argued that the newly added words “merely clarified” what was already implicit
 11 in the claims based on the patent specification. *See id.* at 1250. The court, however,
 12 affirmed the district court’s finding that the newly added limitation was not recited in
 13 the original claims, that the addition was necessary to overcome prior art, and that the
 14 claims were sufficiently narrowed and limited by the additional language that it
 15 constituted a substantive change. *Id.* at 1251. In light of the words of the claims
 16 themselves, the patent prosecution history, and the guidance provided by the Federal
 17 Circuit in *Bloom*, the Court concludes that new claim 20 limits the scope of the original
 18 claim and does not, as Plaintiff suggests, merely clarify the claim.

19 **II. Amended Claim 7 and New Claims 21 and 22**

20 Defendant argues that amended claim 7, and new claims 21 and 22 are also not
 21 substantially identical to original claim 9 because they are all dependent upon new
 22 claim 20. (MSJ 26, ECF No. 40-1.) Accordingly, because these three claims
 23 “incorporate all of the limitations of claim 20,” they are different in scope than original
 24 claim 9. (*Id.* (citing 35 U.S.C. § 112(d) (“A claim in dependent form shall be construed
 25 to incorporate by reference all the limitations of the claim to which it refers.”).)

26 Plaintiff initially argued that new claims 21 and 22 should not be summarily
 27 dealt with based on the analysis of new claim 20 because, unlike new claim 20, they
 28 should be compared with original claim 11 (part (b)) and original claim 12 (part (e)(iii))

1 respectively. (Opp'n 15, ECF No. 43.) However, at the hearing on the instant motion,
 2 Plaintiff's counsel agreed that if the Court finds that new claim 20 is not substantially
 3 identical to original claim 9, then the other remaining claims follow suit.

4 In light of the fact that amended claim 7 and new claims 21 and 22 depend on
 5 new claim 20, which the Court, as explained above, finds is not substantially identical
 6 to original claim 9, the Court concludes that these claims are also not substantially
 7 identical to original claim 9. A dependent claim incorporates "by reference all the
 8 limitations of the claim to which it refers," so new claims 21 and 22, even if most
 9 similar to original claims 11 and 12, also require comparison to original claim 9 (and
 10 original claim 1 for reasons explained above) as a result of their dependence. 35 U.S.C.
 11 § 112(d). The comparison to original claim 9 is the same regardless of whether it is
 12 brought about by analyzing amended claim 7 or new claims 20, 21 or 22. Therefore, the
 13 Court finds that amended claim 7, and new claims 21 and 22, are not substantially
 14 identical to the original claim.

15 **III. Summary Judgment**

16 Based on the conclusion that none of the current claims of the '660 patent are
 17 substantially identical to original claim 9, Defendant argues that it is entitled to
 18 summary judgment on all three of Plaintiff's counts. (MSJ 27, ECF No. 40-1.)

19 First, Defendant asserts that because none of the claims in the reexamined '660
 20 patent are substantially identical to the original '660 patent, "the reexamined '660
 21 patent only has effect from the issuance of the *Ex Parte* Reexamination Certificate on
 22 June 12, 2014." (*Id.* (citing 35 U.S.C. §§ 252, 307(b))).) Accordingly, Defendant argues
 23 that Plaintiff does not have a viable claim for any alleged direct infringement prior to
 24 June 12, 2014. (*Id.*) Defendant further contends that it has "an absolute intervening
 25 right from June 12, 2014 to continue to use, offer to sell, and sell any Accused Products
 26 that were made in the U.S., or imported into the U.S., before that date," such that it
 27 cannot be liable for direct infringement with respect to products made or imported
 28

1 before the issuance of the *Ex Parte* Reexamination Certificate.⁹ (*Id.* (citing *BIC*
2 *Leisure Products*, 1 F.3d at 1220-21).) Defendant also argues that because it has not
3 manufactured in the U.S., nor imported into the U.S., any new Accused Products since
4 June 12, 2014, Plaintiff has no viable claim against Defendant for ongoing direct
5 infringement. (*Id.* at 27–28.)

6 Next, Defendant argues that Plaintiff's claims for indirect and contributory
7 infringement must also fail because “[t]he law is clear that one cannot be liable for
8 indirect infringement without evidence of direct infringement by third parties.” (*Id.* at
9 28 (citing *Joy Tech., Inc. v. Flakt, Inc.*, 6 F.3d 770, 774 (Fed. Cir. 1993) (“Liability for
10 either active inducement of infringement or for contributory infringement is dependent
11 upon the existence of direct infringement.”))). Defendant explains that each of its
12 distributors, resellers, and end user-customers have the same absolute intervening
13 rights under 35 U.S.C. §§ 252 and 307(b) as it does, such that there are also no acts of
14 direct infringement by third parties. (*Id.* at 28–29.) If there is no direct infringement,
15 then, Defendant argues, Plaintiff's claims for indirect infringement must also fail. (*Id.*
16 at 29.)

17 In light of the Court's finding that new claim 20 is not substantially identical to
18 old claim 9, the Court concludes that Defendant is entitled to summary judgment as to
19 all three of Plaintiff's counts in its FAC. A finding that the new claims are not
20 substantially identical to the original claims precludes recovery for infringement from
21 anytime prior to the issuance of the reexamination certificate on June 12, 2014.

23 ⁹Plaintiff argues, in contrast, that Defendant does not have an absolute intervening right
24 because Defendant did not rely on any “perceived infirmities” in the original patent in making
25 its decision to manufacture, sell, and import the accused products. (Resp. in Opp’n 20, ECF
26 No. 43.) To support this argument, Plaintiff relies on an unreported district court case, *Quad*
27 *Envtl. Technologies v. Union Sanitary Dist.*, 17 U.S.P.Q. 2d 1667 (N.D. Cal. 1990), which has
28 been reversed, in which the judge denied intervening rights on the ground that Defendant did
not establish that it relied on infirmities in the original patent. (*Id.*) Although it is unclear,
Plaintiff may be arguing that Defendant is not entitled to equitable intervening rights under 35
U.S.C. § 252, which the Court may award; however, Defendant never asserts that it is entitled
to equitable rights, but rather argues that it is entitled to absolute intervening rights also
outlined in 35 U.S.C. § 252. Regardless of Plaintiff’s intended purpose for including this
argument, the Court does not find it persuasive.

1 Plaintiff offers no evidence of infringement subsequent to the issuance of the
 2 reexamination certificate. Further, without direct infringement there can be no indirect
 3 infringement. *Joy Tech., Inc. v. Flakt, Inc.*, 6 F.3d 770, 774 (Fed. Cir. 1993) (“Liability
 4 for either active inducement of infringement or for contributory infringement is
 5 dependent upon the existence of direct infringement.”).

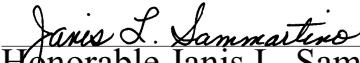
6 The Court concludes that Defendant and its distributors, resellers, and end user-
 7 customers have absolute intervening rights pursuant to 35 U.S.C. § 252 because the
 8 Accused Products were made or imported into the United States prior to the issuance
 9 of the reexamination certificate. Defendant does not refute the fact that Plaintiff has not
 10 made or imported Accused Products since June 12, 2014. Gillig does state that “all of
 11 the R9 and R11 series [golf clubs] sold by Defendant could not have reached
 12 distributors, retailers and end users by June 12, 2014;” however, the inquiry is whether
 13 the Accused Products were made or imported into the United States by that date, not
 14 whether they reached sellers or customers. *See BIC Leisure Products*, 1 F.3d at 1221
 15 (absolute intervening rights cover “products already made at the time of reissue”).
 16 Accordingly, Defendant has absolute intervening rights in regard to the Accused
 17 Products.

18 **CONCLUSION**

19 For the aforementioned reasons, the Court finds that Defendant is entitled to
 20 judgment as a matter of law, and **GRANTS** Defendant’s MSJ. The Clerk of the Court
 21 shall close the file.

22 **IT IS SO ORDERED.**

23
 24 DATED: March 23, 2015

25 
 26 Honorable Janis L. Sammartino
 27 United States District Judge
 28